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DAVIS MUNCK → 917038729319

NO. 123 003

DOCKET NO. 00-C-015 (STM101-00015)
Customer No. 30425

#9
EOTO +
Notice of Appeal
D. Small's Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : ANTHONY M. CHIU
Serial No. : 09/656,985
Filed : September 7, 2000
For : SURFACE MOUNT PACKAGE FOR LINEAR ARRAY
SENSORS
Group No. : 2811
Examiner : N. Parekh

FEE VALUE ACCOUNTABILITY	
DEPOSIT ACCOUNT NO.	
50	0208
FEE CODE	VALUE FORWARDED
1251	

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Commissioner for Patents
Washington, D. C. 20231

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TECHNOLOGY CENTER 2800

Sir:

PETITION UNDER 37 C.F.R. § 1.144

02/26/2003 SDAVIS 00000008 500208 09656985

01 FC:1251

110.00 CR

Pursuant to 37 C.F.R. § 1.144, and prior to entry of Applicant's Notice of Appeal, Applicant respectfully petitions from the Restriction Requirement mailed November 19, 2001.

Applicant traversed the Restriction Requirement in a response filed December 31, 2001, and requested reconsideration of the Restriction Requirement in a response filed January 14, 2003.

The Restriction Requirement restricted claims 1-7, drawn to a method of making a semiconductor device, from claims 8-18, drawn to a semiconductor device.

The Restriction Requirement asserts that the method and device claims are distinct

because the device claims may be manufactured by a materially different process than that

Adjustment date: 06/06/2003 EEKUBAYI
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U.S. SERIAL NO. 09/656,985
PATENT

recited in the method claims. Specifically, the Restriction Requirement asserts that the integrated circuit devices may be packaged after being mounted on the circuit board.

Restriction is only proper where the claims are independent or distinct. MPEP § 806. In passing on questions of restriction, the claimed subject matter must be compared in order to determine distinctness and independence. MPEP § 806.01. In the present application, pending independent claim 1 does not recite packaging the integrated circuit, only that the integrated circuits each include a linear array of photosensors within a portion remaining exposed after packaging. Claims 2 and 6 recite packaging the integrated circuits, but do not specify whether the integrated circuits are packaged before or after being mounted on the circuit board. These claims (as distinct from the exemplary embodiment described in the specification) do not require that the integrated circuit sensor devices be mounted on a circuit board prior to packaging. Accordingly, the restriction requirement has no basis in the claims.

In addition, a process of making and the product made are distinct inventions only if: (A) the process as claimed is not an obvious process of making the product and can be used to make other and different products; and (B) the product as claimed can be made by another and materially different process. The Restriction Requirement asserts that packaging the integrated circuits after they are mounted on the circuit board is materially different than packaging the integrated circuits before they are mounted on the circuit board. However, Applicant respectfully traverses the assertion that packaging the integrated circuits before they are

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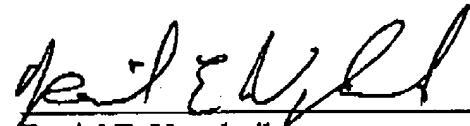
mounted on the circuit board is patentably distinct from packaging the integrated circuits after they are mounted on the circuit board.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 2-11-03


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To: Examiner N. Parekh, Group No. 2811

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From: Daniel E. Venglarik, Esq.

Time: 3:27 PM

Date: February 11, 2003

Client/Matter: 00-C-015 (STMI01-00015)

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Sir:

The undersigned hereby certifies that the following document:

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1. Petition Under 37 C.F.R. §1.144

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relating to the above application was faxed to (703) 872-9319 on February 11, 2003.Date: 2/11/03

FAXER

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